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May 7, 2007  
Date of Signature

PATENT  
**Case No.: AUS920000801US1**  
(9000/11)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:	)	
	)	
STEVEN M. FRENCH, ET AL.	)	Examiner: NGUYEN, THANH
	)	
Serial No.: 09/731,624	)	
	)	
Filed: DECEMBER 7, 2000	)	Group Art Unit: 2144
	)	
Title: METHOD AND SYSTEM FOR	)	
GENERATING A LIST OF OPERATING	)	Conf. No. 1060
SYSTEMS FOR A TARGET DEVICE	)	

**REPLY BRIEF**

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their reply brief as follows:

The Examiner continues to misconstrue the disclosures and teachings of Beelitz as well as the claims.

**A. The Examiner rejected claims 12-20 as anticipated under 35 U.S.C. §102(e) by Beelitz**

With respect to claims 12-20, and specifically independent claim 12, it is well settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have been clear and concise, rather than “vague” as alleged by the Examiner. Claim 12 requires, *inter alia*, “means for receiving at the target device an available operating systems list of at least one operating system available to the target device.” Contrary to the Examiner’s assertions, Beelitz does not disclose such an element. Specifically, Beelitz, at most, discloses “[I]n step 207, control 103 *provides to the user interface 105* a list of the operating system types available.” (emphasis added) at column 7 55-56. Furthermore, “[I]n step 204, *control 103 accesses the master data base 125* to create or generate a list of operating system types available for the targeted computer system” (column 7 lines 35-37).

Control 103 “receives an indication *from a user interface 105* indicating the desire to purchase a computer system.” Column 7, lines 30-32 (emphasis added). Thus, control 103 is distinguished from the targeted computer system 137 (FIG. 1 of Beelitz) and the terminal or user interface 105 (FIG. 1 of Beelitz).

Thus, Beelitz does not disclose “means for receiving at the target device an available operating systems list of at least one operating system available to the target device”, and instead discloses that the “operating systems list” is received at a *user interface 105*. This user interface 105 is distinct and separate from the ‘target device’ since the user interface 105 is in control of the purchaser of a *computer system that has not been built*.

Indeed, such a teaching unequivocally teaches away from the instant invention. As previously noted, Beelitz is addressed to a problem facing computer manufacturers – how to install a desired operating system on a target computer that is the subject of a pending sale of the target computer. “A system for specifying, ordering, and building a build-to-order computer system.” Abstract, Beelitz. Therefore, for Beelitz, presenting the “operating systems list” to the *target device* would be pointless, as *the user does not yet have access to the target device*. In contrast, the instant invention, directed at computer networks wherein “the target device [is] to be remotely booted by the server” as noted in the preamble, “receiving from the server, at the target device, an available operating systems list of at least one operating system available to the target device” would solve a problem facing the inventors. Namely, the claimed invention illustrates how to select a preferred operating system for the target device from the compatible operating systems list and execute the preferred operating system on the target device using a remote boot.

The Examiner’s citation to column 16, lines 35-38 (extended selection below) further illustrates the failure of Beelitz to disclose each and every element of claim 12, and further demonstrates that Beelitz teaches away from the claimed invention.

In other embodiments, a user may select other hardware components to be implemented on a targeted computer system. For example, in one embodiment, the user is presented a list of hard drives compatible with the CPU and operating system selected. In other embodiments, the user is presented with a list or lists of compatible peripheral devices. For example, the present invention may also be used by a purchaser to select a compatible type of modem to be installed in the target computer system as well as the type or types of disk drives or CD ROM drives. Other options that could be presented to a user with the present invention include various types of computer chassis, keyboards, and displays. Each hardware component and software program presented to a user would be compatible with the previous selection or selections made by the user. In some embodiments, each type of hardware component would be presented in sub menu or sub-list. Each of the entries for the additional hardware items would include associated tags which indicate compatibility with previous choices.

In the instant case, the hardware components of the target device are already known (or at least pre-determined) to the user – the user is operating the target device in their presence, and is selecting an operating system to remotely boot the target device.

Because Beelitz fails to disclose “means for receiving at the target device an available operating systems list of at least one operating system available to the target device” as claimed in claim 12, and claims 13-20 depending therefrom, this §102(e) rejection must fall.

**B. The Examiner rejected claims 1-11 and 21-27 as unpatentable over Beelitz in view of DeSimone**

In order to maintain this §103(a) rejection, each and every claim element must be taught or suggested by the references, alone or in combination, in at least as great detail as claimed. Since Beelitz in view of DeSimone fails to teach or suggest “receiving from the server, at the target device, an available operating systems list of at least one operating system available to the target device,” as claimed in claims 1 and 24 or “means for sending an available operating systems list from a server to a target device, the target device to be remotely booted by the server, prior to executing an operating system on the target device” as claimed in claim 21, this rejection must fall.

First, even if the combination of references were proper, which it is not, the combination fails to teach the claimed invention. The claims require receiving from the server, at the target device, an available operating systems list of at least one operating system available to the target device. At most, the references teach that a list is sent to a user – not a target device.

Combining Beelitz’s teachings with sending a “list of the subnetwork addresses of each client” (DeSimone, column 5, lines 47-51) fails to teach or suggest each and every element of the claims, and therefore the §103(a) rejection is flawed for at least this reason.

The Examiner's reliance on DeSimone to teach "server sends a list" is misplaced for at least two reasons. One, whether or not DeSimone teaches "server sends a list" any such teaching does not teach receiving from the server, at the target device, an available operating systems list of at least one operating system available to the target device, and the Examiner properly does not rely on Beelitz to cure such a defect. The Examiner specifically, and correctly, notes that Beelitz does not teach such an element.

Furthermore, DeSimone does not teach that the "list" taught by "server sends a list" is an "available operating systems list" as claimed. Rather, DeSimone teaches sending a list of the "subnetwork addresses of each client I to all sending clients  $j(j \neq I)$  via optional headers." See, DeSimone, column 5, lines 47-51 as cited by the Examiner. Such a teaching is a far cry from the claimed elements and therefore, the references fail to teach or suggest each and every claim limitation for at least this additional reason.

Additionally, and as noted above, Beelitz unequivocally teaches away from the claims – there is no rational basis for the Examiner to assert that one of ordinary skill in the art would be motivated to modify Beelitz as suggested by the Examiner. Thus, any combination of a reference with Beelitz cannot support a rejection under §103(a).

Modification of Beelitz as suggested by the Examiner would destroy the principle of operation of Beelitz, and therefore the §103(a) rejection is improper. Even if Beelitz were so modified as to send an operating systems list from the server to a user, such actions would result in the target device (i.e., the computer being purchased by the user) sitting on an assembly line – hardly a desirable result.

Furthermore, Beelitz in view of DeSimone does not disclose "a method of dynamically creating a list of operating systems for a target device in communication with a server prior to executing an operating system on the target device," as claimed in independent claim 1. Furthermore, Beelitz does not disclose "the target device [is] to be remotely booted by the server."

Per MPEP §2111.02, the preamble of a claim is to have “the import that the claim as a whole suggests for it. In claim 1, the claim as a whole suggests the limitation that the target is a remotely booted device, and Beelitz does not disclose this element. Beelitz is addressed to a problem facing computer manufacturers – how to install operating systems on computers that are being assembled. Beelitz discloses a method of installing operating systems for target computers that will be separated from the network, shipped to an end user, and then booted. *See, inter alia*, the Abstract of Beelitz, disclosing a “system for specifying, ordering, and building a build-to-order computer system.” DeSimone teaches a method of transferring connection management information in world wideweb requests and responses.

In contrast to the Beelitz disclosure, the instant case addresses problems faced by network administrators with target devices that are remotely booted on a network.

At most, Beelitz discloses that a targeted computer system 137 is initially booted up to perform the operations and instructions as per associated shell script files to load the selected programs onto its hard drive and to run the tests. In one embodiment, the selected software programs and operating systems can be down loaded and installed on the targeted computer system via the Internet. *See*, column 15, lines 1-7. Thus, Beelitz does not disclose “the target device to be remotely booted by the server” – Beelitz teaches only loading and installing the operating system onto the targeted computer system to boot the system.

For example, *see* FIG. 5, and step 520 from Beelitz, column 14, lines 30-55. Beelitz uses a data file to implement the selections per the data file on the targeted computer system. “Thus, the selected operating system, selected software programs, selected patches, selected hard drive operations, the determined always run parts, and other selections are *installed, implemented and tested* by the execution of the associated shell script files. (column 14, lines 37-42) (emphasis added) “The script processing program interprets the instructions of the shell script files and acts upon those instructions *to perform the actual instructions for the installation or implementation of the part on the computer system.*” (column 14, lines 46-50) (emphasis added).

Withdrawal of the rejections to claims 1, 21, 24 and claims 2-11, 22-23, and 25-27 depending therefrom is requested.

**SUMMARY**

The Appellants respectfully request withdrawal of these rejections, and that this case pass to immediate allowance, and submit that claims 1-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **May 7, 2007**

Respectfully submitted,  
STEVEN M. FRENCH, *et al.*

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